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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,684	01/04/2002	Robert P. Schnall	01/22882	7802

7590 05/18/2005  
G E Ehrlich (1995) LTD  
c/o Anthony Castorina  
2001 Jefferson Davis Highway  
Suite 207  
Arlington, VA 22202

EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/019,684

Applicant(s)

SCHNALL, ROBERT P.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected less than 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites that the housing has 3 separate but contiguous sections. Applicant has asserted that Goldberger 4685464 does not have separate but contiguous sections because they are continuous. However, all 3 sections of applicant's invention share a common, continuous outer wall. It is unclear that what the definition of separate and contiguous is, especially since the terms appears to be contradictory.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 25, 26, and 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Goor et al. The examiner submits that there are 2 ways to view Goor.

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First, there is figure 6C, which shows a distal section enclosing area Co, a middle section having bladder 40, and a proximal section 95, where the pressurizing means pressurizes the distal and middle portions. The second way to view the reference is that it has a distal section, housing pad 91, a middle section housing chamber Co and a proximal section having bladder 40, where the pressurizing means pressurizes all three sections. Claim 25 is rejected in that the heartward most chamber, i.e. proximal chamber 40, acts as a venous tourniquet. Claims 26 is rejected in that, the flexible rubber used for the membranes in Goor is a sponge. Applicant on page 13, line 18 of the specification states that a sponge cushion may be made from a sponge rubber or the like. It is the examiner's position that the flexible membrane is a "sponge rubber or the like." Claim 30 is rejected in that the housing is sized to fit 2 phalanges, depending on the hand size. Claim 31 is rejected in that judging by the nature of use of the device, the device is inherently "approximately" 50 mm long. Claims 32 and 34 are rejected in that in figures 2-4, the housing only has 2 sections, a proximal and distal section, a sensor, and a pressurizing means. Claim 33 is rejected for the reasons given above.

Claims 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Muz. Muz shows a device having a housing 1 for receiving a patient's body pad, having a distal section including bladder 7 and a proximal section without the bladder, pressurizing means 5, that are equivalent to applicant's, for pressurizing the distal section, and sensor 15 and 17, where the proximal end section includes a soft elastic silicon rubber inner wall. Applicant on page 13, line 18 of the specification states that a

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sponge cushion may be made from a sponge rubber or the like. It is the examiner's position that a soft, elastic silicon rubber wall a "sponge rubber or the like."

Claims 1, 2, 25, 26, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberger et al. Goldberger et al shows a device including a housing 10 for receiving a finger, where the housing has three contiguous portions, a distal portion of members 70 and 80, that is distal to the sensor (right in figure 3), a middle portion housing the sensor and a proximal portion proximal to the sensor (to the left in figure 3), where the device includes means 40 to apply a pressure to the distal portion. The examiner notes that the device has a length sufficient to cover 2 phalanges and its length is "approximately 50 mm".

Claims 3-24, and 27-29 would be allowable if the rejection under 35 USC 112, first paragraph were overcome and if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 3-24 define over the art of record in that none of the art has 3 contiguous chambers, as recited, where the pressurizing means is formed of a deformable membrane means, as claimed. Claims 27 and 28 define over the art in that none of the art has two sensors, one in the middle and one in the proximal sections. Claim 29 defines over the art in that none of the art has the claimed air vents.

Applicant's arguments filed 7/27/2004 have been fully considered but they are not persuasive.

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Applicant has argued that Muz does not have a sponge. The examiner disagrees, noting that the record does not define a sponge. The specification says the sponge is made from a material that is sponge rubber or the like. The examiner submits that the soft rubber of Muz fits that category.

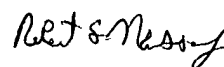
Applicant has further asserted that the sections of Goldberger are not separate and contiguous. As discussed above, the definition of these terms is unclear. However, the examiner notes that each section appears to have a different function than the adjacent section(s) and as such, they are separate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner



ROBERT L. NASSER  
PRIMARY EXAMINER